

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Yi-Qun Li, Robert C. O'Handley, Gerald F. Dionne and Chun Zhang

Application No.: 09/358,177 Group: 2862

Filed: July 20, 1999 Examiner: Patidar, J.

For: PASSIVE SOLID-STATE MAGNETIC FIELD SENSORS AND APPLICATIONS
THEREFOR

#13/Election
10/10/01



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REPLY TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Responsive to the Restriction Requirement dated August 13, 2001, the claims of Group I (Claims 6-20 and 24) drawn to a multilayered magnetic field sensing device are elected for prosecution, with traverse. Applicants reserve the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicants do not hereby abandon or waive any rights in the non-elected inventions.

An extension of time to respond to the Restriction Requirement is respectfully requested. A Petition for an Extension of Time and the appropriate fee are being filed concurrently.

Applicants respectfully traverse the restriction between Group I and Group III and rejoinder of the two groups is requested. Applicants traverse the restriction requirement on the grounds that Groups I and III, as defined by the Examiner, do not represent independent or distinct inventions. Specifically, Applicants propose that the claims of Group III (claim 23) be rejoined with those of Group I. Applicants maintain that the claims of Groups I and III are but different characterizations of the same disclosed subject matter, varying only in breadth or scope

of definition. More specifically, the claims of these groups relate to magnetic field sensors having magnetostrictive and piezoelectric material.

According to MPEP § 803, the two criteria for a proper requirement for a restriction are that the inventions must be independent or distinct as claimed, and that there must be a serious burden on the Examiner. It is noted that the requirement of a serious burden on the Examiner may be *prima facie* shown if the claims at issue have separate classifications. This *prima facie* showing, of course, may be rebutted by an appropriate showing by the Applicants.

In this case, the Examiner asserts that the Group I claims are drawn to the subject matter of class 324, subclass 260 (magnetic field detection devices) and that the single claim of Group III is drawn to the subject matter of class 324, subclass 244 (magnetometers). It is evident from the descriptions corresponding to each of these subclasses, that the subject matter of these two subclasses are directed to nearly identical art. Class 324, subclass 244, is defined as:

“subject matter wherein the apparatus to sense and indicate the sensing of a magnetic field is responsive to the intensity of the sensed magnetic field or the direction of the sensed magnetic field.”

Class 324, subclass 244, on the other hand, is defined as:

“subject matter which includes magnetic field sensing devices, *per se*, which are not classified elsewhere.”

It is noted that subclass 260 even cross-references subclass 244, which further illustrates the similarity between respective subject matter. It is submitted that even if these two groups are assigned to different subclasses, any burden on the Examiner in this particular case would be minimal as the field of search between the two groups would be substantially similar, if not identical. It is therefore urged that the two groups, I and III, be rejoined.

Moreover, the Examiner has classified the Group I claims as falling under subclass 260, which is a “catch-all” category that includes magnetic field sensing devices that do not fall into any of the other categories. Applicants submit, however, that the claims of Group I may be more appropriately categorized under subclass 244, where these claims, like the single claim of Group III, refer to apparatus for sensing magnetic fields that are responsive to the intensity or direction

of the sensed magnetic field. The Group I claims clearly meet this description, as they are directed to magnetic field sensors responsive to an alternating magnetic field, where the field must necessarily be alternating in intensity and/or direction. For this reason, Applicants submit that the restriction is traversed.

Applicants therefore traverse the requirement for restriction, and respectfully requests that it be withdrawn, and that the claims of Groups I and III be rejoined and examined in this application.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

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